

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:)	Group Art Unit:	2155
CHAN et al.)		
)	Examiner:	Liangche WANG
Serial No.: 10/622,982)		
)	Confirmation No.:	2989
Filed: July 17, 2003)		
)		
Atty. File No.: 4366-124)		
)		

PRE-APPEAL BRIEF
REQUEST FOR REVIEW

For: "METHOD AND APPARATUS FOR
RESTRICTION OF MESSAGE
DISTRIBUTION FOR SECURITY"

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The outstanding Office Action rejects claims 1, 3, 5-8, 10-11, 13-17, 19, 21-24, 26-27, 29-31, 36, 37, 39, 41-44, 46-47, and 49 under 35 U.S.C. §102(e) as being anticipated by Olivier (U.S. 6,480,885); claims 2, 4, 18, 20, 38, and 40 under 35 U.S.C. §103(a) as being unpatentable over Olivier in view of Clarke, et al. (U.S. 2003/0065727A1), claims 9, 25, and 45 under 35 U.S.C. §103(a) as unpatentable over Olivier in view of Tsuei (U.S. 6,654,779), and claims 12, 28, and 48 under 35 U.S.C. §103(a) as being unpatentable over Olivier in view of Canale, et al. (U.S. 5,619,648).

Appellants respectfully submit the Office Action fails to meet the *prima facie* requirements to support a valid rejection under 35 U.S.C. §102 and/or 35 U.S.C. §103.

Independent Claim 1 recites, *inter alia*, receiving a message from a sender, the message comprising **(I)** at least one recipient to receive the message and including at least one of **(a)** a restriction identifier, the restriction identifier identifying a subset of recipients from among a set of possible recipients and **(b)** an access restriction indicating a subset of points of access from among a set of points of access to access the message;

determining whether each identified at least one recipient is within the subset of recipients corresponding to the restriction identifier; and wherein at least one of the following steps is performed:

(i) when the message comprises the restriction identifier and an identified at least one recipient is not within the subset of recipients, at least one of **(A)** not providing access to the message to the identified at least one recipient who is not in the subset of recipients and **(B)** notifying the sender that an identified at least one recipient is not within the subset of recipients; and

(ii) when the message comprises the access restriction and an identified at least one recipient attempts to access the message from a point of access not within the subset of points of access, not providing access to the message to the identified at least one recipient whose point of access is not within the subset of points of access. [Bold identifiers added]

Independent Claim 16 recites, *inter alia*, receiving at least part of a message inputted by a user, the at least part of a message comprising at least one recipient to receive the message;

receiving, from the user, a restriction identifier for the at least part of a message, the restriction identifier identifying a subset of recipients from among a set of possible recipients ; and

when a restriction identifier is received, tagging the message with the restriction identifier.

Independent Claim 36 recites, *inter alia*, an input operable to receive at least part of a message inputted by a user, the at least part of a message comprising at least one recipient to receive the message, and a restriction identifier for the at least part of a message, the restriction identifier identifying a subset of recipients from among a set of possible recipients; and

when a restriction identifier is received, a processor operable to tag the message with the restriction identifier.

Olivier is directed to a method for enabling users to exchange group electronic mail by establishing individual profiles and criteria for determining personalized subsets within a group. Users establish subscriptions to an electronic mailing list by specifying user profile data and *acceptance criteria* data to screen other users. When a user subscribes, a web server establishes

and stores an individualized recipient list including each matching subscriber and their degree of one-way or mutual match with the user. When the user then sends a message to the mailing list, an email server retrieves 100% of subscriber matches and then optionally filters the recipient list down to a message distribution list *using each recipient's message criteria*. The message is then distributed to matching users. A subscribing user may specify acceptance criteria in the matching algorithm. The matching algorithm may be facilitated by including, in the email body or subject line, a keyword in brackets such as “[for sale]”.

In general, the above reference and the other cited references, taken either alone or in combination, fail to teach or suggest (a) the use of restriction identifiers to prevent electronic mail distribution to a ***recipient designated by the sender***, (b) the use of restriction identifiers to ***prevent access*** of electronic mail ***from a set of communication devices*** otherwise associated with a recipient, and (c) the use of restriction identifiers to ***limit the ability*** of an electronic mail recipient ***to forward*** the received electronic mail to others.

None of the references provide the sender with the ability to create a message that **(I)** identifies a recipient and **(a)** includes a restricting identifier identifying a subset of recipients from among a set of possible recipients, and then (i) when the identified recipient is not within the subset of recipients continues by **(A)** not providing the ***identified*** recipient access to the message and/or **(B)** notifying the sender that the ***identified*** recipient is not within the subset of recipients.

As discussed in accordance with an exemplary embodiment, the restriction identifier of the present invention can: (i) be a forwarding restriction indicating one or both of whether or not the message may be forwarded and to whom the message may be forwarded; (ii) be an access restriction indicating that the message may be accessed only from predetermined points of access, such as points of access internal to a network; and/or (iii) refer to other conditions besides class of eligible recipients. The restriction identifier impacts ***negatively*** what users can access a particular message or even the way that a user is allowed to access a message. Creating restriction identifiers allows a sender to control the distribution of his/her message even after the message has been sent.

In contrast, it is abundantly clear that in Olivier, it is the end user (*i.e.* the recipient) that is specifying the acceptance criteria data - **not** the sender as set forth in Independent claims 1, 16 and 36. Similarly, in Canale, while a recipient specifier is discussed, it does not restrict access to a communication in a manner similar to that claimed, but is rather used by a mail filter at the “recipient” to determine whether the recipient desires to receive the message. Moreover, Olivier does not teach any situation where an identified recipient is not within the subset of recipients. At most, the acceptance criteria discussed in Olivier creates a subset of recipients from among a set of possible recipients. Nowhere in Olivier is there a teaching of *identifying* a recipient that may or may not be a part of a subset of recipients from among a set of possible recipients.

Regarding feature **(b)** and any claim interpretations (*e.g.*, **(I)(b)(i)** and/or **(I)(b)(ii)**) including such a feature, the Office Action states that the use of restriction identifiers to prevent access of electronic mail from a set of communication devices otherwise associated with a recipient is disclosed at Fig. 9, col. 3, lines 17-22, col. 5, lines 47-49, and col. 12, lines 59-65 of Olivier. Contrarily, Olivier makes clear that a “recipient” refers to a person or subscriber and not a device. There are no restrictions for a subset of devices, each of which may be associated with the same recipient. Thus, Olivier teaches that a matching subscriber is forwarded the email, even if not addressed specifically to the subscriber. Olivier does not distinguish between which of the matching *subscriber’s devices* receives the email let alone specify that the matching subscriber cannot access the message at some of that subscriber’s message retrieval nodes.

With respect to feature (c) the Office Action states that the use of restriction identifiers to limit the ability of an electronic mail recipient to forward the received electronic mail to others and forwarding the restriction on the message itself is disclosed by Olivier (which discloses the general concept of a restriction identifier) and Canale (which teaches the limitation of the forwarding restriction being on the message itself). As noted above, Olivier and Canale do not teach a restriction identifier that impacts *negatively* who is eligible to receive the message. At col. 4, lines 1-9, Canale teaches that the sender can select which of a list of recipients can receive a message. However, Canale does not teach that the sender can continue to restrict a message recipient’s ability to forward the message to others.

In addition to the proffered arguments, and with respect to Independent claims 16 and 36, none of the cited references teach, suggest, or describe **tagging** a message with a restriction identifier that will **negatively** restrict access to that message.

At least based upon the above, Appellants respectfully submit the independent claims are patentably distinguishable from the cited references. By virtue of their dependency, and the additional features recited therein, the dependent claims are also allowable.

For example, dependent claims 10, 26 and 46 include an age restriction. Applicants respectfully submit the relied upon portion of Olivier is directed toward a "subscription expiration date" - not an age limit of the message as claimed.

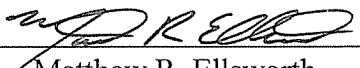
Claims 11 and 27 specify that a timestamp indicates when a life of a message starts. There is nothing in either the relied upon portion of the reference nor any other portion of the cited references that teaches a timestamp indicating when a life of a message starts.

Claims 12, 28 and 48 state that the message includes the forwarding restriction and one of whether the message may be forwarded and to whom the message may be forwarded. In contrast, in Canale, it is the models that are determining forwarding, not a forwarding restriction on the message itself.

At least based on the above, Appellants respectfully request reconsideration of the application on the merits and prompt passage to issuance.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: 
Matthew R. Ellsworth
Registration No. 56,345
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

Date: May 3, 2007